

REMARKS/ARGUMENTS

Claims 1-16 are pending. At the outset, Applicant gratefully acknowledges the indication of allowable subject matter in claims 8-14.

Reconsideration of the amended claims is respectfully requested.

Amendments to the Claims

Dependent claim 8 is amended above into independent form, including the features of underlying base claims 7 and 6. Claims 9-14 each depend, either directly or indirectly, from newly independent claim 8. Therefore, Applicant respectfully submits that claims 8-14 are all in condition for allowance.

Claims 1, 6 and 10 are amended above for readability only, and do not alter the scope of the claims as previously presented. The noted editorial amendments to claim 6 are reflected by its incorporation into claim 8. No new matter has been added, nor any new issues raised by these amendments. Applicants respectfully submit that they are proper for entry notwithstanding the Final Rejection.

Claim Rejections

In the Office Action, the Examiner rejected claims 1-7 and 15-16 under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 4,906,137 to Maloberti, *et al.* ("Maloberti"). Applicants respectfully traverse the rejection, for at least the following reasons.

Claim 1 is a method for starting up a flowline that extends over the seabed between a wellhead and a joint end. The joint end is suitable for connecting the flowline to a subsea riser. The method includes the steps of inducing elongation of the flowline and a subsequently fixing the joint end to the seabed to maintain the flowline in the elongated position.

The Office Action asserts that Maloberti discloses these features with reference to the hose (3) of Figs. 1-4 and at col. 1, line 67-col.2, line 2. Applicants respectfully disagree. The portion of Maloberti cited by the Office Action (Col. 1, line 67 - Col. 2, line 2) states, in full:

In the "STEEP S" or "STEEP WAVE" configuration, the portion of the hose between the intermediate element and the subsea floor is stretched, the lower end of the hose being fastened to a base resting on the floor.

Where the claim recites inducing elongation of the flowline extended over the seabed from the wellhead and terminating at a joint end, Maloberti describes maintaining the hose stretched between the intermediate element and the seabed. The intermediate element is earlier described by Maloberti as "an arch of concavity turned toward the subsea floor, if necessary connected to the subsea floor by tie rods, a group of positive buoyancy elements (buoys) placed in succession and fastened to the hose" (Col. 1, lines 43-47; See. Fig. 1, Ref. 4). Moreover, the manner of connection disclosed in Maloberti, e.g., tie rods 8, clamped collar 6, prevent any transmission tension in that 'stretched' hose 3b to the portion that lies on the seabed floor, *i.e.*, 3c. See also Col. 3, lines 63. ("[H]ose part 3b below element 4 is made taut by being fastened to a deadman 5 placed on the subsea floor.") Moreover, the disclosure in Maloberti is that the portion of the flowline on the seabed, 3c, is not translated in any way despite elongation of section 3b. This is illustrated undeniably in Fig. 4, where the movement of the portion 3b, and/or any flexing of portion 3d, does not alter the position of the seabed hose portion 3c.

Therefore, Maloberti does not teach or suggest inducing an elongation in said flowline, namely the flowline extended over the seabed from the wellhead and terminating at a joint end. For at least this reason, Applicant respectfully submits that claim 1 is patentably distinguished over Maloberti.

Turning to claim 2, this claim recites "permitting displacement of the joint end in a direction of elongation of said flowline, and prohibiting displacement of the joint end in an opposite direction". The Office Action alleges that this feature is taught in Maloberti because the reference teaches that the length of hose can be achieved by linking several partial lengths of hose, Col. 4, lines 27-32. However, with regard to "said flowline" in question, namely the portion from the wellhead over the seabed to the joint end, Maloberti teaches a clamping collar 10, and tie rods 5, which do not permit displacement in one direction while prohibiting it in an opposite direction.

Further, even if the lengths of the hose in Maloberti may be altered by insertion of additional modular sections, this does not affect any control over the displacement of any particular joint end of the hose as recited in the claim. To the contrary, increasing the length of the hose by insertion of additional sections would seem to simply increase the propensity for stretch therein in either an elongating or contracting direction, and would have no effect on prohibiting displacement of the joint in an opposite direction of elongation. In any case, Applicants respectfully traverse that the insertion of additional pipe sections falls within the scope of "permitting displacement of the joint end in a direction of elongation of said flowline, and prohibiting displacement of the joint end in an opposite direction" as recited in claim 2. Therefore, Applicants respectfully submits that for any of these several reasons, claim 1 is separately distinguished over Maloberti.

Turning to claim 3, this claim recites said joint end is guided in translation during elongation of said flowline. The Office Action alleges, without more, that this feature is inherent in Maloberti. Applicant respectfully disagree.

To support a *prima facie* case of anticipation by inherency, the limitation in question must "necessarily" be present in the prior art reference. *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). *See also, Akamai Technologies, Inc. v. Cable & Wireless Internet Services, Inc.*, 344 F.3d 1186, 68 USPQ2d 1186 (Fed. Cir. 2003) ("A claim limitation is inherent in the prior art if it is necessarily present in the prior art, not merely probably or possibly present.")

In this case, the Office Action makes only a bare allegation of inherency, without setting forth any underlying basis to support such a conclusion. For at least this reason, Applicants respectfully submits that the rejection of claim 3 is poorly taken, and kindly request favorable reconsideration and withdrawal.

Claims 4-5 and 16 depend on claim 1 and incorporate its features by reference. These claims are each separate patentable, but in the interest of brevity they are offered as patentable over Maloberti for the same reasons discussed above.

Claims 6 is a system claims that include features corresponding to those features recited in method 1, and is therefore submitted as patentable for at least the same reasons as claim 1. Claims 7 and 15-16 depend on claim 6, and are therefore submitted as patentable over Maloberti for at least the same reasons as their underlying independent base claim, the features of which are incorporated by reference.

Conclusion

In view of the foregoing discussion, withdrawal of the rejections and allowance of the claims of the present application are respectfully requested. Should the Examiner have any reservation in allowing the claims, she is kindly requested to telephone Applicants' undersigned representative at her earliest convenience to schedule a telephone interview.

Respectfully submitted,

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